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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,798	12/15/2006	Masahiro Hanmura	U 0162226	7704
140	7590	06/14/2007		
LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			EXAMINER KLEMANSKI, HELENE G	
			ART UNIT 1755	PAPER NUMBER
			MAIL DATE 06/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/573,798

Applicant(s)

HANMURA ET AL.

Examiner

Helene Klemanski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/28/06</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The abstract of the disclosure file on December 15, 2006 is objected to because it is more than one paragraph in length. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "selected from" (two occurrences) is considered indefinite since this is improper Markush language. It is the examiner's position that other materials could be present in the Markush group that were not intended by applicants by the use of the phrase "selected from" since this phrase does not exclude other materials. The examiner suggests the language "selected from the group consisting of" in place of this phrase.

In claims 8-10, the terms "used" and "using" are indefinite. A "process" defined in the sole terms of "use of" does not define patentable subject matter under 35 USC 101. See *In re Fong*, 129 U.S.P.Q. 264 (CCPA 1961). The examiner suggests incorporating defined method steps into the above claims to overcome this rejection.

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Claim 11 is considered confusing since it is dependent upon two different claims. The examiner suggests incorporating the ink composition as defined in claim 1 into claim 11 or incorporating the method according to claim 10 into claim 11 to overcome this rejection.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 6, 9, 11-16 and 18-21 of copending Application No. 10/951,446 (US 2005/0115459). Although the conflicting claims are not identical, they are not patentably distinct from each other

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because the claims of the present application are generic to said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 18, 19, 34 and 35 of U.S. Patent No. 7,211,132. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are generic to said patent claims and would be obvious thereby.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

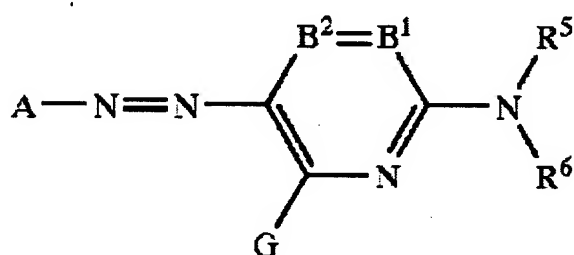
8. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hanmura et al. (US 2005/0115459)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome

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either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Hanmura et al. teach a magenta ink jet ink composition comprising: (A) water or an aqueous medium, (B) at least one dye of the formula (1)



wherein A represents a residue of a 5-membered heterocyclic diazo component $A-NH_2$; B^1 and B^2 represent $-CR^1=$ and $-CR^2=$ respectively, or one thereof represents a nitrogen atom and the other thereof represents $-CR^1=$ or $-CR^2=$; R^5 and R^6 each independently represents H, an aliphatic group, an aromatic group, a heterocyclic group, an acyl group, an alkoxycarbonyl group, an aryloxycarbonyl group, a carbamoyl group, an alkylsulfonyl group, an arylsulfonyl group or a sulfamoyl group, each group being optionally substituted; G, R^1 and R^2 each independently represents H, a halogen atom, an aliphatic group, an aromatic group, a heterocyclic group, a cyano group, a carboxyl group, a carbamoyl group, etc., each group being optionally substituted and R^1 and R^5 , or R^5 and R^6 may be bonded together to form a 5- or 6-membered ring, (C) at least one anthrapyridone dye of the formula (2) and (D) at least one aromatic compound having a carboxyl group or a salt thereof. The aromatic compound having a carboxyl

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group is preferably a compound having a naphthalene skeleton such as 2-naphthoic acid, 3-hydroxy-2-naphthoic acid, 6-hydroxy-2-naphthoic acid and 6-methoxy-2-naphthoic acid and the salts are preferably lithium. The weight ratio of the total content of the at least one dye of the above formula (1) and the at least one anthrapyridone dye of the formula (2) to the total content of the at least one aromatic compound having a carboxyl group or a salt thereof is in a range of 5:1 to 1:3. Hanmura et al. further teach a process for printing comprising ejecting the above ink jet ink composition onto a substrate. See para. 0008, para. 0011, paras. 0020-0022, para. 0024, para. 0027, paras. 0029-0034, paras. 0036-0039, para. 0044, Tables 1-6, paras. 0118-0122, para. 0124, Table 7; Examples 11-15 and claims 1, 3, 4, 6, 9-16 and 18-21. The ink jet ink composition as taught by Hanmura et al. appears to anticipate the present claims.

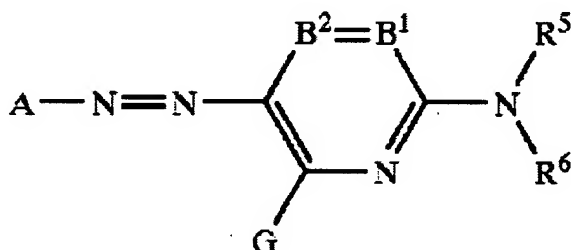
9. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

10. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Oki et al. (US 7,211,132)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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Oki et al. teach an ink jet ink set comprising a cyan ink, a magenta ink, a yellow ink and a black ink. The magenta ink comprises: (A) water or an aqueous medium, (B) at least one anthrapyridone dye of the formula (2), (C) at least one dye of the formula (4)



wherein A represents a residue of a 5-membered heterocyclic diazo component A-NH₂; B¹ and B² represent $-CR^1=$ and $-CR^2=$ respectively, or one of them represents a nitrogen atom and the other represents $-CR^1=$ or $-CR^2=$; R⁵ and R⁶ each independently represents H, an alkyl group, an alkenyl group, an alkynyl group, an aralkyl group, an aryl group, a heterocyclic group, an acyl group, an alkoxycarbonyl group, an aryloxycarbonyl group, a carbamoyl group, an alkylsulfonyl group, an arylsulfonyl group or a sulfamoyl group, each group being optionally substituted; G, R¹ and R² each independently represents H, a halogen atom, an alkyl group, an alkenyl group, an alkynyl group, an aralkyl group, an aryl group, a heterocyclic group, a cyano group, a carboxyl group, a carbamoyl group, etc., each group being optionally substituted and R¹ and R⁵, or R⁵ and R⁶ may be bonded together to form a 5- or 6-membered ring and (D) at least one naphthalene-based aromatic compound having a carboxyl group at the second position or a salt thereof such as 2-naphthoic acid, 3-hydroxy-2-naphthoic acid,

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6-hydroxy-2-naphthoic acid and 6-methoxy-2-naphthoic acid and the salts are preferably lithium. The weight ratio of the total content of the at least one anthrapyridone dye of the formula (2) and the at least one dye of the above formula (4) and to the total content of the at least one naphthalene-based aromatic compound having a carboxyl group at the second position or a salt thereof is in a range of 1:0.5 to 1:10. Oki et al. further teach a process for printing comprising ejecting the above ink jet ink composition onto a substrate. See col. 3, lines 65-67, col. 5, lines 6-55, col. 6, lines 26-32 and lines 55-63, col. 10, lines 50-55, col. 18, line 44 – col. 19, 50, Dyes 1-17, Dyes b-1, b-2, c-1 and c-2, col. 40, lines 34-39, col. 41, lines 22-57, col. 42, lines 4-13 and lines 36-43, col. 45, line 28 – col. 46, line 10, Table 1; Ink Compositions M-12 and M-13, Table 2; Ink Compositions LM-12 and LM-13 and claims 1, 7, 18, 19, 34 and 35. The ink jet ink composition as taught by Oki et al. appears to anticipate the present claims.

11. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

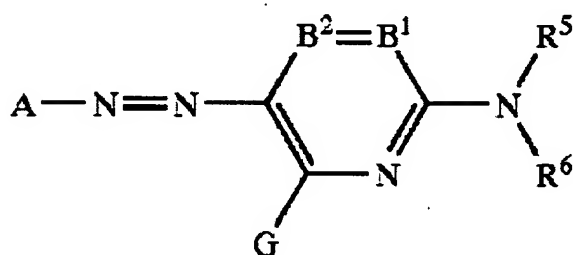
Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-3 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2003/246942.

JP 2003/246942 teach a magenta ink jet ink composition comprising: (A) water or an aqueous medium, (B) at least one dye of the formula (2)



wherein A represents a residue of a 5-membered heterocyclic diazo component A-NH₂; B¹ and B² represent -CR¹= and -CR²= respectively, or one thereof represents a nitrogen atom and the other thereof represents -CR¹= or -CR²=; R⁵ and R⁶ each independently represents H, an aliphatic group, an aromatic group, a heterocyclic group, an acyl group, an alkoxycarbonyl group, an aryloxycarbonyl group, a carbamoyl group, an alkylsulfonyl group, an arylsulfonyl group or a sulfamoyl group, each group being optionally substituted; G, R¹ and R² each independently represents H, a halogen atom, an aliphatic group, an aromatic group, a heterocyclic group, a cyano group, a carboxyl group, a carbamoyl group, etc., each group being optionally substituted and R¹ and R⁵, or R⁵ and R⁶ may be bonded together to form a 5- or 6-membered ring and optionally (C) an antifungal agent such as sodium benzoate. See paras. 0012-0013, paras. 0043-0050, Tables 1-4 and para. 0066 of the English translation (copy provided). JP 2003/246942 fails to specifically exemplify the addition of sodium benzoate (i.e.

aromatic compound having a carboxyl group) to the magenta ink composition as claimed by applicants.

Therefore, it would have been obvious to one having ordinary skill in the art to have added the specific sodium benzoate as claimed by applicants as JP 2003/246942 also discloses the use of these antifungal agents but fails to show an example incorporating them.

Conclusion

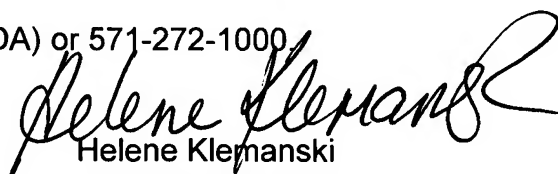
The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Helene Klemanski
Primary Examiner
Art Unit 1755



HK
June 8, 2007